

Remarks

Upon entry of the foregoing amendments, claims 1-16, 18, and 20-22 are pending in the application. Claims 5, 9, 14, and 16 have been amended to clarify the subject matter contained therein. New claims 21 and 22 have been added. The amendments and new claims do not introduce any new subject matter within the meaning of 35 U.S.C. §132. Therefore, entry of the amendments is respectfully requested.

SUMMARY OF RESTRICTION REQUIREMENT

Election of Groups: The Examiner has withdrawn the restriction requirement dated August 24, 2001 in favor of the following requirement:

Group I: claims 1-18, drawn to a method of treating disturbances or illnesses of the inner ear, comprising administering at least one vasopressin receptor antagonist.

Group II: claims 19 and 20, drawn to a pharmaceutical composition or medicament containing at least one vasopressin receptor antagonist.

Additionally, the Examiner requires an election of species to which the claims shall be limited if no generic claim is allowed.

ELECTION

Applicants provisionally elect Group I, claims 1-18, with traverse.

Applicants provisionally elect the species of claim 12, i.e., indole derivative that is 1-[4-(N-tert.-butyl carbamoyl) -2-methoxybenzene sulphonyl]-5-ethoxy-3-spiro-{4-(2-morphonlinoethoxy) -cyclohexane} -indol-2-one fumarate, with traverse. Claims reading on this species are: 1-6, 9, 10, 12 and 14-18.

TRAVERSAL

Applicants respectfully traverse the Examiner's restriction requirement and the requirement for the election of species.

Applicants respectfully point out that the restriction requirement issued by the Examiner is improper under 35 U.S.C. § 121. As indicated in *In re Watkinson*, "... it is never proper for an examiner to reject a Markush claim under 35 U.S.C. § 121." "Section 121 simply does not authorize such a rejection." *Id.* The board's decision in *Holt* not only recognizes this legal principle but explicitly notes that with regard to section 121, the

rejection of a Markush claim is different from a restriction requirement between different claims..." (900 F.2d 230, 1990 U.S. App., 14 U.S.P.Q. 2D 1407); Cf. Holt, 214 USPQ at 384 (discussing *In re Orita*, 550 F.2d 1277, 193 U.S.P.Q. (BNA) 145 (CCPA 1977)). Thus, it is improper to require a restriction within a SINGLE claim. As such, it is incorrect for the present claims to be subject to a restriction under section 121.

Applicants submit that claim 12 is not generic. Specifically, the instant specification, at page 5, second paragraph states, "indole derivatives...are known fundamentally from WO 93/15051, WO 95/18105 and EP-A1-645375", and each of these documents includes the phrase "indole derivatives" within its title. Accordingly, one of ordinary skill in the art clearly will understand that any indole derivate, as presently claimed in claim 12, will include the well-known entity "indole". Clearly, this definition will include a considerable but well-defined number of compounds. For this reason, Applicants respectfully request that the Examiner reconsider the election of species requirement and allow the election of claim 12.

Further, at the Examiner's disposal are powerful electronic search engines providing the Examiner with the ability to quickly and easily search all of the claims. Considering that the Examiner will most likely undertake a search for all of the generic claims in the application, searching for the remainder of the claims would be minimally burdensome on the Examiner.

Moreover, given the overlapping subject matter, examination of the claims in this application would not pose a serious burden, because the searches would be coextensive in that a search of any one of the invention Groups I and II would require searching the prior art areas appropriate to the other invention Group.

Finally, Applicants note that upon allowance of a generic claim, Applicants will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 C.F.R. 1.141.

In view of the foregoing, Applicants respectfully request the Examiner to reconsider and withdraw the restriction requirement and examine all claims pending in this application.

CONCLUSION

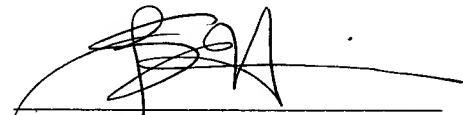
If the Examiner has any questions or wishes to discuss this matter, he is welcomed to contact the undersigned attorney.

Respectfully submitted,

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